

In the Advisory Action mailed April 11, 2006, the Examiner stated that it was unclear from the Declaration under 37 CFR 1.132 filed March 24, 2006 whether the inventive ink composition described in the declaration corresponds to Example B2 or Example B3 of the present specification. The Examiner courteously acknowledged that, if the inventive ink is actually that of Example B3, then the declaration would be successful in establishing unexpected or surprising results over the cited art and would successfully overcome all of the 35 USC 103 rejections of record.

Applicants advise that the inventive ink actually used in the experimentation described in the declaration is that of Example B3. Applicants submit herewith a corrected Declaration under 37 CFR 1.132, which makes this clear. It is respectfully considered that the submission of this declaration establishes unexpected or surprising results that rebuts the alleged *prima facie* case of obviousness and overcomes the 103 rejections in accordance with the Examiner's comments.

The Examiner has continued the rejection under 35 USC 102(e) for alleged anticipation by Ota et al on the basis that Ota et al allegedly "clearly names" the claimed species. Applicants respectfully disagree.

First, Applicants respectfully note that the "species" being claimed is not 1,2,6-hexanetriol or 1,2-hexanediol, but **a combination comprising both these and the other claimed components. This claimed combination is not** clearly named in the reference.

Rather, to arrive at the claimed combination from the reference disclosure requires picking and choosing from among a huge number of components, including **but not limited to** selection of a specific wetting agent from (among others) the comprehensive list of wetting agents described in the reference at, for example, paragraphs [0099], [0102], [0103], [0104], [0105] and [0106], **in combination with** a specific auxiliary agent selected from (among others) the comprehensive list of auxiliary agents described in the reference at, for example, paragraphs [[0197] and [0198]. In other words, to arrive at the claimed combination, one must select from a **vast number of possible combinations** of components, including (in the case of the auxiliary agent) optional components, and not just from the eleven (11) high boiling low volatility polyhydric alcohols listed in paragraph [0197].

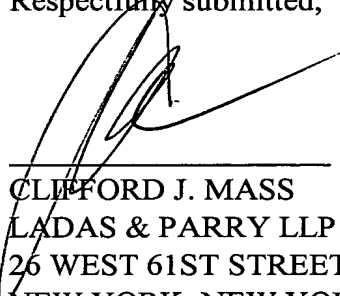
Moreover, Applicants respectfully note that the eleven (11) high boiling low volatility polyhydric alcohols listed as auxiliary agents in paragraph [0197] are duplicative of wetting agents listed in paragraph [0099]. If one of skill in the art should pick, for example, 1,2-hexanediol as the auxiliary agent for use in an ink composition in accordance with the teachings of the reference at paragraph [0197], there would have been no motivation also to include in the ink composition a wetting agent such as 1,2,6-hexanetriol since, in accordance with the teachings of the reference at paragraph [0099], the 1,2-hexanediol could also serve as the wetting agent.

In a case where, as here, one must select randomly from among a vast number of possible combinations of components in a reference to arrive at a claimed combination, without any indication that the claimed combination is preferable to any other of the possible

combinations, the case law is clear that there is no anticipation under the provisions of 35 USC 102. See, for example, *Akzo N.V. v. International Trade Comm'n*, 1 USPQ2d 1241, 45-46 (Fed. Cir. 1986) (affirming that no anticipation existed where one would have to randomly pick and choose among a number of different polyamides, a plurality of solvents and a range of inherent viscosities to arrive at claimed invention).

In view of the above, it is respectfully considered that the rejection under 35 USC 102(e) should be withdrawn and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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